

REMARKS

In the Office Action mailed on September 18, 2008 the Examiner held that the reissue oath/declaration filed with the application was defective because:

- 1) The "duty to disclose" statement was improper as it did not properly reference 37 CFR 1.56.
- 2) It failed to clearly identify an error being corrected in the instant application in accordance with 37 CFR 1.173.

In response to the first objection Applicants have submitted an amended reissue/oath declaration that does properly reference 37 CFR 1.56. In response to the second objection, Applicants respectfully submit that the declaration does in fact identify an error being corrected in the instant application and is in accordance with 37 CFR 1.173. Statements 6 and 7 of the signed declarations submitted by both inventors point out that the specification discloses subject matter having to do with the simultaneous recording of video program materials onto different media that the claims as issued do not fully reflect.

The Examiner held that the attempt to incorporate subject matter into this application by reference to the patents as stated in page 1 of the specification is ineffective because it is not clear what material or limitation is being incorporated or referenced. Applicants respectfully submit that on page 1, lines 6-9 of the amended specification, it is clearly stated that the entire contents of U.S. Patent Application Serial No. 09/900,784, filed July 6, 2001, which is a continuation of U.S. reissue application Serial No. 09/016,777, filed January 30, 1998, now U.S. Patent No. RE37,342, which is a reissue of U.S. Patent No. 5,488,433, which is a continuation-in-part of U.S. application Serial No. 08/298,104, filed Aug. 30, 1994, now U.S. Patent No. 5,537,157, and U.S. application Serial No. 08/050,861, filed Apr. 21, 1993, now [patented] U.S.

Patent No. 5,450,140, are incorporated by reference. Applicants further submit that all copending patent applications and reissue applications have been fully disclosed on page 1 of the amended specifications.

Applicants respectfully submit that the Certificates of Corrections granted in U.S. Patent No. 5,537,157 and U.S. Patent No. 5,488,433 have been incorporated into the specification amendments to the extent to which they are applicable.

The application was rejected by the Examiner under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. In response, a proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 has been submitted.

Claims 51-69 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 51-68 of copending Application No. 11/003,834. Claims 51-63, 65-77 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 51-66 of copending Application No. 11/003/580, and claims 51-68 of copending Application No. 11/003,579, and claims 51-68 of copending Application No. 11/003,576. In response, Applicants respectfully submit Terminal Disclaimers to Obviate a Provisional Double-Patenting Rejection Over a Pending "Reference" Application attached hereto.

On the grounds that the specification doesn't support the new limitation "computer-readable medium" as it doesn't disclose a singular medium for performing storage step, claims 51 and 60 have been amended to correct this problem. It is respectfully submitted claims 65-77 should not be subject to this rejection since they do not contain the limitation "computer-readable medium."

Substantive examination of the application is respectfully solicited.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 07-1180.

Dated: 1/20/09

Respectfully submitted,

By 

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